

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 12-28 are now present in this application. Claims 12, 13, 17, and 20 are independent. Claims 1-11 have been canceled without prejudice to being presented in a continuing patent application. Claims 23-28 are added and claims 12-17 and 19 are amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

I. Title of the Invention

The Examiner has required a new title, alleging that the existing title is not descriptive. No reason is given concerning why the current title is not descriptive.

Nevertheless, in the interest of expediting prosecution, Applicants have amended the title of the invention. Applicants respectfully submit that the new title of the invention is descriptive of the invention.

II. Drawing Changes

Applicants thank the Examiner for accepting the drawing changes proposed in the Amendment filed on September 7, 2004.

III. Claim Objection

Claim 12 is objected to for a reason that is unclear to Applicants. The Examiner states that he has concluded that step (d) in claim 12 refers to recording the test data into a “second field,” and notes that recording the test data in a second field is not positively recited in claim 12. The Examiner then states that “appropriate correction is required.”

Applicants respectfully submit that there is no requirement for them to positively recite recording test data in a separate field. In this regard, Applicants note that claim 12 is an originally filed claim and is part of Applicants’ original disclosure, thereby fully complying with 35 USC §112, first paragraph.

Nevertheless, in the interest of expediting prosecution, Applicants have amended claim 12 to recite recording optional data, as test data, onto a second field of the test area, and reproducing the test data recorded on the second field.

Applicants respectfully submit that claim 12 fully complies with all statutory requirements, and withdrawal of this objection is respectfully requested.

IV. Rejections Under 35 U.S.C. § 102 and § 103

Claims 1-3, 17, and 18 stand rejected under 35 U.S.C. § 102(b/e) as being anticipated by U.S. Patent 5,872,763 to Osakabe or U.S. Patent 5,978,351 to Spruit et al. (hereinafter, "Spruit") or U.S. Patent 6,646,965 to Kim. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because claims 1-3 have been canceled without prejudice, this rejection is moot with respect to claims 1-3.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Anticipation requires that each prior art reference contain within its four corners all of the elements of the claimed invention found in substantially the same situation where they do substantially the same work in the same way. *Atlas Powder Co. v. E.I. du Pont de Nemours and Co.*, 588 F.Supp. 1455 [221 USPQ 426] (N.D. Texas 1983), *aff'd*, 750 F.2d 1569 [224 USPQ 409] (Fed. Cir. 1984); *Ecolchem, Inc. v. Mobile Water Technology Co.*, 690 F.Supp. 778 [8 USPQ2d 1065] (E.D. Ark. 1988), *aff'd*, 871 F.2d 1096 [10 USPQ2d 1557] (Fed. Cir. 1989). Moreover, a rejection under 35 USC §102(e) cannot properly be based on speculation. See, in this regard, *In re GPAC, Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

Furthermore, when relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily follows from the teachings of the applied art. See, *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BD. Pat. App. & Int. 1990). There can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something may result from a given set of circumstances is not sufficient. *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art."

Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Applicants will discuss each reference as it is applied, i.e., separately.

1. Osakabe

Claims 17 and 18 positively recite a re-writable optical recording medium having a test area for recording test data, the test area comprising a first field on which a value of a factor having an influence on recording characteristics is recorded as test data, while being varied and at least one second field on which a value of another factor having an influence on recording characteristics is recorded, as test data, while being varied.

The Office Action fails to point out, and Applicants have not been able to find, in Osakabe, where the recited first and second fields exist. Osakabe discloses only one predetermined test area – see col. 5, lines 6-27, especially line 15, and col. 1, lines 40-60, especially line 46, with absolutely no mention of a first field for recording a value of one factor and a second field for recording a value of another factor. Applicants respectfully submit that, at best, Osakabe discloses a single predetermined test area with no disclosure, either express or inherent, of the recited first and second fields. Thus, Osakabe does not anticipate claims 17 and 18.

The Office Action states that the Examiner interprets the disclosure in col. 6, lines 35-36 of Osakabe as providing a first and second field. Applicants respectfully disagree. The only parameter varied in that portion of Osakabe is erasing power intensity, which is a single field (as recited in claims 17 and 18).

The Office Action also states that “varying a characteristic value of the recording pulses other than recording power values” is not found in claims 17-18.

Applicants respectfully point out that claim 18 positively recites that the first field is a field on which a recording power value is recorded as test data while being varied for detection of an optimum recording power.

Moreover, Applicants have amended claim 17 to positively recite that the value of another factor includes a format of recording pulse for a determination of a recording signal format involving an optimum recording condition, which is a feature added from claim 19, which has been indicated as containing allowable subject matter.

2. Spruit

Spruit fails to disclose, either expressly or inherently, the recited first and second fields in claims 17 and 18. Spruit discloses recording a series of test patterns on the medium, each pattern having a different value of the recording parameter. However, Spruit also discloses that the recording process may include erasure of previously recorded information either by direct

overwrite or in a separate pass. See col. 1, lines 30-62. Thus, Spruit does not expressly or inherently (necessarily) disclose a re-writable optical recording medium having a test area for recording test data, the test area comprising a first field on which a value of a factor having an influence on recording characteristics is recorded as test data, while being varied and at least one second field on which a value of another factor having an influence on recording characteristics is recorded, as test data, while being varied, as recited.

The Office Action responds to this argument by referring to col. 4, lines 55-63, which discloses test patterns being recorded with a different write power in different test areas. This only discloses varying a single factor, write power, in a different number of test areas, whereas claims 17 and 18 recite varying a value of another factor having an influence on the recording characteristic in the second field. This is not disclosed by Spruit. The Office Action also refers to col. 4, lines 15-30, which do not disclose recording the different factors in different fields, as recited.

Moreover, Applicants have amended claim 17 to positively recite that the value of another factor includes a format of recording pulse for a determination of a recording signal format involving an optimum recording condition, which is a feature added from claim 19, which has been indicated as containing allowable subject matter.

3. Kim

The assertion in the Office Action that claims 17 and 18 are disclosed in Tables 1 and 2 of Kim fails to address the positively recited features of claims 17 and 18 and fails to make out a *prima facie* case of anticipation of the claimed invention by Kim.

In response to this argument, the Office Action notes that Kim discloses writing the test signal at least 3 times at various power levels and interprets each time as a field.

Applicants respectfully submit that claims 17 and 18 make it clear that a test area is comprised of fields, and to interpret the steps of writing a test signal at various power levels as fields is improper and does not comply with the meaning of a “field” in claims 17 and 18.

The statement that “[T]he examiner could introduce Osakabe under 103 considerations” is not a rejection, but a merely speculative statement to which Applicants do not have to respond unless and until a rejection of claims 17 and 18 under 35 USC §103(a) is actually made of record. In fact, such a speculative statement violates Applicants’ substantive and procedural due process rights to be fully informed of any rejection of Applicants’ claims under the Administrative Procedures Act, is not proper in an Office Action and should be withdrawn. Applicants’ rights under the Administrative Procedures Act are

discussed, for example, in In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Moreover, Applicants have amended claim 17 to positively recite that the value of another factor includes a format of recording pulse for a determination of a recording signal format involving an optimum recording condition, which is a feature added from claim 19, which has been indicated as containing allowable subject matter.

Accordingly, none of Osakabe, Spruit, or Kim anticipates claims 17 and 18. The rejection of claims 17 and 18 under 35 USC §102(b/e) as anticipated by Osakabe or Spruit or Kim is improper and should be withdrawn, and claims 17 and 18 allowed.

Accordingly, claims 17-18 are not anticipated by any of the applied references.

Claims 1-3, 17, and 18 stand rejected under 35 USC 102(e) as anticipated by U.S. Patent 6,775,218 to O'Neill et al. (hereinafter, "O'Neill").

This rejection is respectfully traversed.

This rejection is moot with respect to claims 1-3 in view of the cancellation of claims 1-3 without prejudice.

With respect to claims 17 and 18, Applicants respectfully submit that the Examiner's interpretation of first and second pulses shown in Fig. 5C as

different field, is inconsistent with the definition of fields in those claims. Claims 17 and 18 make it clear that a test area is comprised of fields, and to interpret specific pulses shown in Fig. 5C as fields is improper and does not comply with the meaning of a "field" in claims 17 and 18.

Claims 1-3 are rejected under 35 USC 103(a) as being unpatentable over Osakabe considered with either U.S. Patent 6,172,951 to Ohba or U.S. Patent 5,974,021 to Toda et al. (hereinafter, "Ohba").

This rejection is respectfully traversed as moot in view of the fact that claims 1-3 have been canceled without prejudice.

Claims 4, 5, and 10 stand rejected under 35 USC §102(e) as being anticipated by Osakabe. This rejection is respectfully traversed as moot because claims 4, 5 and 10 have been canceled without prejudice.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art applied in the rejection of claims 4 and 5, above, in view of Spruit. This rejection is respectfully traversed as moot in view of the cancellation of claims 6 and 7 without prejudice.

Claim 11 stands rejected under 35 USC §103(a) as being unpatentable over the art applied in the rejection of claims 4, 5 and 10, above, further in view of U.S. Patent 5,732,061 to Kirino et al. (hereinafter, "Kirino"). This rejection is respectfully traversed as moot in view of the cancellation of claim 11 without prejudice.

Claims 4, 5, and 10 stand rejected under 35 USC §102(b/e) as being anticipated by Osakabe or Spruit, respectively (paragraph No. 7 of the Office Action). This rejection is respectfully traversed as moot in view of the cancellation of claims 4, 5, and 10 without prejudice.

Claims 4 and 5 stand rejected under 35 USC §102(e) as being anticipated by Kim (paragraph 8). This rejection is respectfully traversed as moot because claims 4 and 5 have been canceled without prejudice.

Claims 6 and 13 stand rejected under 35 U.S.C. § 102(b/e) as being anticipated by either EP '584 or Spruit. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

The rejection is moot with respect to claim 6, which has been canceled without prejudice.

Applicants note that this rejection is incorrect with respect to claim 13, which has been indicated as being allowed.

The totality of the rejection is a single sentence, i.e., “[T]he above documents disclose the additional feature/second test data (factor) as jitter.”

This single sentence does not address all of the claimed features and is, therefore, fatally deficient on its face, to make out a *prima facie* case of anticipation of the claimed invention by either reference.

Moreover, the rejection of claim 13 only addresses jitter and does not address the positively recited feature of “while varying a format of recording signals.”

Accordingly, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation of the invention recited in claim 13 by either EP ‘584 or Spruit.

Accordingly, claim 13 is not anticipated by either Spruit or EP ‘584.

V. Allowable and Allowed Subject Matter

Applicants thank the Examiner for indication that claims 13-16 and claims 20-22 are allowed.

The Office Action Summary, Form PTO-326, states that claim 12 contains allowable subject matter, but needs to be amended to overcome an objection thereto. Applicants traverse the objection, above, and respectfully submit that claim 12 is allowable in its present form, for reasons stated above. Claims 13-16 and 20-22 are said to be allowed. Unfortunately, claim 13 is also rejected under 35 USC 102 as anticipated by Spruit or EP'584, on the very same page that states that claim 13 is allowed. Clarification of this inconsistency is requested.

Under the circumstances, Applicants consider that claim 13 is allowed and that the inclusion of the rejection of claim 13 (as paragraph 9 on page 8) was inadvertent, in view of the express statement on page 8 of the Office Action referring to the rejection of claim 13 over Spruit or EP '584, that "such is not the case," and the indication on the Form PTO-326 that claims 13-16 and 20-22 are allowed.

In any event, clarification is required.

VI. New Claims

Applicants have added new, dependent, claims 23-28, each of which is allowable at least because the claim from which it depends is allowable, for reasons stated above.

VII. Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

VIII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Applicants also request withdrawal of the statement that "the Examiner could introduce Osakabe under 103 considerations" for the reasons stated above.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

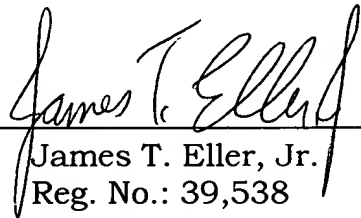
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Reply to November 12, 2004 Office Action

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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